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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,987	08/20/2003	Marybeth Ahern	00240293US	5154

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Andrew M. Calderon
Greenblum and Bernstein P.L.C.
1950 Roland Clarke Place
Reston, VA 20191

EXAMINER

KARDOS, NEIL R

ART UNIT	PAPER NUMBER
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3623

MAIL DATE	DELIVERY MODE
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11/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/643,987	Applicant(s) AHERN ET AL.	
	Examiner Neil R. Kardos	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 32-41 and 52-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 32-41 and 52-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/21/09</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is a **NON-FINAL** Office Action on the merits in response to communications filed on September 21, 2009. Currently, claims 1-8, 10, 32-41, and 52-63 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 21, 2009 has been entered.

Response to Amendment

Applicant's amendments to the claims are sufficient to overcome the § 112 rejections set forth in the previous Office Action.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10, 32-41, and 52-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan, "Aligning Enterprise Architecture and IT Investments with Corporate Goals" in view of Frank, "Multi-Perspective Enterprise Modeling (MEMO) – Conceptual Framework and Modeling Languages," and further in view of Golightly (US 2003/0046130).

Claim 1: Buchanan discloses a method for managing and tracking changes, the method comprising the steps of:

- defining at least one customer requirement for an enhancement to an enterprise architecture (see page 1, paragraph 1, disclosing delivering and linking new enterprise solutions; page 1, paragraph 3, disclosing corporate goals and priorities; page 2, paragraph 1, disclosing identifying opportunities; page 5, paragraph 2, disclosing identifying opportunities);
- identifying at least one capability to provide the enhancement to the enterprise architecture (see page 1, paragraph 3, disclosing aligning IT projects with corporate goals and priorities; page 2, paragraph 1, disclosing identifying opportunities and recommending appropriate investments based on the opportunities; page 2, paragraph 2, disclosing aligning IT with corporate goals; figure 3, depicting aligning systems with processes and goals; page 5, paragraph 3, disclosing identifying which assets will engage in processes to support business strategy; page 5, paragraph 4; page 6, paragraphs 3-4);

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- estimating at least one of a revenue increase and a cost saving associated with the at least one capability (see page 3, paragraph 3, disclosing value as financial efficiency, which includes reducing costs or enhancing financial yield);
- determining a value provided by the at least one capability based upon an implementation cost and the at least one of a revenue increase and the cost saving (see page 3, paragraph 3, disclosing value as a reflection of financial efficiency and business effectiveness);
- using a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels with one or more dynamic links that differ between the plurality of levels (see page 2, paragraph 3, disclosing a hierarchy that extends from the business strategy level to the IT implementation level and allows the organization to align business goals and IT investment plans; figure 3, depicting a business process that is linked to overall strategy and is supported by an application and technology infrastructure within a value chain; page 6, paragraphs 3-4, disclosing linking technology to program/project initiatives and defining relationships between processes and infrastructure; figures 4 and 5, depicting linking different levels of the enterprise architecture);

Buchanan does not explicitly disclose the remainder of claim limitations. Frank discloses:

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- displaying the hierarchical relationship between the goal, the value which is associated with the goal, the at least one capability which represents critical functions for ensuring delivery of the value, and one or more resources which enables the at least one capability (see figure 4, depicting a display of "Generic Strategy" linked to "ValueChain" linked to "Activity" linked to "Resource"; page 2, column 2, paragraph 1, disclosing a "permanent representation of all relevant aspects on an enterprise (strategy, business processes, organizational structure, business entities, business rule, etc.)"; figure 1, depicting goals, processes, structure, and resources; page 4, section 3.3, paragraph 1, disclosing "means to navigate through the views of an enterprise model on various levels of detail");
- using a system implemented on a computer platform to partition information relevant to enterprise decision making for evolutionary change by creating categories of information and relating these categories to one another, the information being defined by at least one of the value, the at least one capability, and operational resources (see figure 4, described above; page 3, section 3.1, disclosing partitioning the information);
- using an automated system to manage the categories of information (see page 4: section 3.3, disclosing computer tools used to manage the categories).

Buchanan and Frank are both directed to enterprise modeling. Buchanan discloses requirements for achieving business goals, capabilities to achieve those requirements, and a value associated with the capabilities, as well as storing a relationship between these items. Frank discloses displaying the relationships between these items and managing the items on a

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computer system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system disclosed by Frank to store, display, and manage the hierarchical items disclosed by Buchanan. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained through the visualization of the model (see Frank, page 2, section 2, paragraph 2, disclosing that visualization of models contributes to a better understanding).

Buchanan and Frank do not explicitly disclose capturing and linking process measurements from one or more external modeling tools to the database to allow process performance to be accessed by the system. Golightly discloses this limitation (see paragraph 77, disclosing receiving process data; paragraph 83-85, disclosing receiving performance data values and models; paragraphs 105-107, disclosing external inputs; paragraphs 140 and 143, disclosing production performance). Buchanan, Frank, and Golightly are all directed to frameworks for modeling a business. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine aspects of Golightly's architecture with aspects of the architectures of Buchanan and Frank. This combination of known elements retains the functionality of the separate elements and produces a result that would be predictable to one of ordinary skill in the art. Furthermore, One of ordinary skill in the art would have been motivated to add the performance measurements of Golightly to the architectures of Buchanan and Frank for the benefit of efficiencies gained by tracking performance and using results to make better decisions.

Claim 2: Buchanan discloses:

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- mapping the at least one customer requirement to the at least one capability (see page 1, paragraph 3, disclosing aligning IT projects with corporate goals and priorities; page 2, paragraph 1, disclosing identifying opportunities and recommending appropriate investments based on the opportunities; page 2, paragraph 2, disclosing aligning IT with corporate goals; figure 3, depicting aligning systems with processes and goals; page 5, paragraph 3, disclosing identifying which assets will engage in processes to support business strategy; page 5, paragraph 4; page 6, paragraphs 3-4; Examiner's note: Frank also teaches this limitation – see at least figure 4); and
- comparing the value provided by the at least one capability with another value provided by at least one other capability and determining which capability provides optimum value (see page 7, paragraphs 1-2, disclosing that investments are made according to objective measure of business strategic value; Examiner's note: Golightly also teaches this limitation – see paragraphs 77, 86, 115, 129, and 133, as well as figure 6).

Claim 3: Buchanan discloses wherein the identifying step includes identifying one or more strategic resources to support the at least one capability (see sections cited in the rejection of claim 1; Buchanan discloses IT infrastructure for supporting corporate goals; Examiner's note: Frank also discloses this limitation – see at least figure 4).

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Claim 4: Buchanan discloses wherein the identifying at least on capability step includes identifying at least one of a business process (see figure 3), a personnel skill/competency, a physical entity (see figure 3, disclosing technology infrastructure), an information technology (see figure 3, disclosing applications and infrastructure), a system component (see id.), and an infrastructure component (see id.).

Claim 5: Buchanan discloses assigning a weight to the one or more strategic resources and prioritizing the one or more strategic resources based on the assigned weight (see page 7, paragraphs 1-2, disclosing assigning priorities for investments; Examiner's note: Golightly also teaches this limitation – see paragraphs 25, 53-54, and 158-159). Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to assign weights and prioritize elements in view of those weights.

Claim 6: Buchanan discloses assigning outcome based performance metrics to the one or more strategic resources (see page 3, paragraph 3, disclosing objective measure that capture aspects of value; page 7, paragraphs 1-2, disclosing objective measures of business value; Examiner's note: Golightly also discloses this limitation – see paragraphs 85, 103, 140, and 143).

Claim 7: Buchanan and Frank do not explicitly disclose the limitations of this claim. Golightly discloses implementing and tracking the one or more strategic resources based on the outcome based performance metrics (see ¶ 85, disclosing providing performance information; ¶ 103, disclosing throughput and production rates of machinery; ¶ 140, disclosing production

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attributes such as cost, quality, yield, and capacity; ¶ 143, disclosing production rate, cycle times, quality summaries, and running production tallies). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the business management techniques of Golightly into the framework disclosed by Buchanan and Frank in order to track performance of implemented projects. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately and efficiently determining the impact of implemented projects.

Claim 8: Buchanan discloses assigning a weight to the at least one capability and prioritizing the at least one capability based on the assigned weight (see page 7, paragraphs 1-2, disclosing assigning priorities for investments; Examiner's note: Golightly also teaches this limitation – see paragraphs 25, 53-54, and 158-159). Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to assign weights and prioritize elements in view of those weights.

Claim 10: Buchanan discloses assigning outcome based performance metrics to the at least one capability (see page 3, paragraph 3, disclosing objective measure that capture aspects of value; page 7, paragraphs 1-2, disclosing objective measures of business value; Examiner's note: Golightly also discloses this limitation – see paragraphs 85, 103, 140, and 143).

Buchanan and Frank do not explicitly disclose tracking the at least one capability based on the outcome based performance metrics. Golightly discloses this limitation (see ¶ 85, disclosing providing performance information; ¶ 103, disclosing throughput and production rates

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of machinery; ¶ 140, disclosing production attributes such as cost, quality, yield, and capacity; ¶ 143, disclosing production rate, cycle times, quality summaries, and running production tallies).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the business management techniques of Golightly into the framework disclosed by Buchanan and Frank in order to track performance of implemented projects. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately and efficiently determining the impact of implemented projects.

Claims 32-41 and 52: Claims 32-41 and 52 are substantially similar to claims 1-8 and 10, and are rejected under similar rationale.

Claim 53: The cited references do not explicitly disclose wherein the at least one customer requirement is defined in response to a request by a customer. However, the cited references at least suggest this limitation because they discuss corporate goals, and corporate goals are a reflection of customer value. Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to define customer requirements in response to a request by a customer (e.g. through the use of customer surveys or feedback). It would have been obvious to one of ordinary skill in the art at the time the invention was made to define the requirements of Buchanan in response to a customer request, as is well-known in the art. One of ordinary skill in the art would have been motivated to do so for the benefit of value gained through responding to customers.

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Claim 54: Buchanan discloses wherein the value is monetary or in terms of strategic business worth (see page 3, paragraph 3).

Claim 55: Buchanan and Frank do not explicitly disclose wherein the outcome based performance metrics are defined and tested by conducting facilitates working sessions or building simulation models. Golightly teaches this limitation (see Golightly generally; the disclosure is directed to predictive models). It would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the simulations of Golightly when analyzing the impact of changes to the enterprise frameworks of Buchanan and Frank. One of ordinary skill in the art would have been motivated to do so for the benefit of a more efficient and accurate way to measure the impact of changes.

Claim 56: Buchanan and Frank do not explicitly disclose wherein the estimates are at least one of entered, recorded, or modified as additional real performance information is observed. Golightly discloses this limitation (see at least ¶ 83). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the estimates taught by Golightly when analyzing the impact of proposed to the enterprise frameworks of Buchanan and Frank. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate indication of the impact that a change will have on an enterprise.

Claim 57: Buchanan and Frank do not explicitly disclose allowing at least one organizational executive to track functionality and flag one or more of the at least one capability.

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Golightly discloses tracking and flagging capabilities (see at least ¶¶ 29-33 and 83).

Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to flag areas of concern while tracking and monitoring performance. Thus, It would have been obvious to one of ordinary skill in the art at the time the invention was made to flag certain capabilities while tracking and monitoring performance as disclosed by the cited references. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by closely monitoring areas of concern.

Claim 58: Buchanan discloses using the assigned weight to make a decision based on one or more of the implementation cost, the revenue increase, and the cost saving (see page 3, paragraph 3; page 7, paragraphs 1-2).

Claim 59: Buchana discloses providing the user with a plurality of dynamic links to operational elements of the system (see page 2, paragraph 3, disclosing a hierarchy that extends from the business strategy level to the IT implementation level and allows the organization to align business goals and IT investment plans; figure 3, depicting a business process that is linked to overall strategy and is supported by an application and technology infrastructure within a value chain; page 6, paragraphs 3-4, disclosing linking technology to program/project initiatives and defining relationships between processes and infrastructure; figures 4 and 5, depicting linking different levels of the enterprise architecture; Examiner's note: Frank also discloses this limitation – see figure 4). The cited references do not disclose every one of the claimed links. However, the claimed links amount to non-functional data such as a mere arrangement of data.

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Such nonfunctional descriptive material is not given patentable weight absent a new and unobvious functional relationship between the nonfunctional matter and the substrate. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); MPEP 2106.01. Where the only difference between the prior art product and the claimed invention is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); MPEP 2112.01(III).

Claim 60: Buchanan and Frank do not explicitly disclose storing updates to the database dynamically as changes are made to the hierarchical relationship. Golightly discloses this limitation (see abstract). Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to save updates to a database when changes are made. It would have been obvious to one of ordinary skill in the art at the time the invention was made to save the models of Buchanan and Frank to a database as they are changed according to the disclosure of Golightly and the knowledge of one of ordinary skill in the art. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by storing the correct and most recent versions of documents.

Claim 61: Buchanan discloses using the system to transition the at least one capability into actual operations (see page 1, paragraph 1, disclosing implementing new solutions quickly).

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Claim 62: Buchanan discloses determining whether the at least one capability supports and satisfies a customer value (see page 1, paragraph 3, disclosing aligning projects with goals; page 2, paragraphs 2-3; page 3, paragraph 3, disclosing valuing investments; page 7, paragraphs 1-2).

Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan, Frank, and Golightly, and further in view of Chalmeta, "References Architectures for Enterprise Integration."

Claim 63: The cited references do not explicitly disclose conducting a tradeoff analysis and a business case analysis, the tradeoff analysis being based on a cost, a time factor, and a benefit. Chalmeta discloses this limitation (see page 188: column 1: paragraph 2, disclosing a cost/benefit analysis and meeting physical requirements; page 190: section 12, disclosing decision support systems; page 183: column 2: item 3, disclosing sorting priority of short, medium, and long term projects). It would have been obvious to one of ordinary skill in the art at the time the invention was made to conduct a tradeoff analysis as disclosed by Chalmeta when considering the investment decisions disclosed by Buchanan. One of ordinary skill in the art would have been motivated to do so for the benefit of selecting the most effective and efficient projects to implement.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- Khananghinis (US 2004/0059611), directed to modeling frameworks and architecture in support of a business.
- Buteau (US 6,442,557), directed to evaluating an enterprise architecture model.
- Schwerin-Wenzel (US 2004/0254806), directed to aligning execution of an organization with strategies of the organization.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos
Examiner
Art Unit 3623

/Neil R. Kardos/

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Examiner, Art Unit 3623

/Jonathan G. Sterrett/

Primary Examiner, Art Unit 3623